

1 WILLIAM L. ANTHONY (State Bar No. 106908)
ERIC L. WESENBERG (State Bar No. 139696)
2 HEIDI L. KEEFE (State Bar No. 178960)
ORRICK, HERRINGTON & SUTCLIFFE, LLP
3 1000 Marsh Road
4 Menlo Park, CA 94025
Telephone: 650-614-7400
5 Facsimile: 650-614-7401

6 STEVEN ALEXANDER (admitted *Pro Hac Vice*)
KRISTIN L. CLEVELAND (admitted *Pro Hac Vice*)
7 JAMES E. GERINGER (admitted *Pro Hac Vice*)
8 JOHN D. VANDENBERG
KLARQUIST SPARKMAN, LLP
9 One World Trade Center, Suite 1600
121 S.W. Salmon Street
10 Portland, OR 97204
Telephone: 503-226-7391
11 Facsimile: 503-228-9446

12 Attorneys for Defendant and Counterclaimant,
13 MICROSOFT CORPORATION

14 UNITED STATES DISTRICT COURT
15 NORTHERN DISTRICT OF CALIFORNIA
16 OAKLAND DIVISION

17 INTERTRUST TECHNOLOGIES
CORPORATION, a Delaware corporation,

18 Plaintiff,

19 v.

20 MICROSOFT CORPORATION, a
Washington corporation,

21 Defendant.

22 MICROSOFT CORPORATION, a
Washington corporation,

23 Counterclaimant,

24 v.

25 INTERTRUST TECHNOLOGIES
CORPORATION, a Delaware corporation,
26 Counter Claim-Defendant.
27
28

CASE NO. C01-1640 SBA

**MICROSOFT CORPORATION'S
PATENT LOCAL RULE 4-2
DISCLOSURE OF PRELIMINARY
CLAIM CONSTRUCTION AND
EXTRINSIC EVIDENCE (LIMITED
TO "MINI-MARKMAN" CLAIMS)**

1 Pursuant to Patent Local Rule 4-2 and this Court's Order, entered November 5, 2002,
2 Defendant Microsoft Corporation ("Microsoft") hereby serves its "Disclosure Of Preliminary
3 Claim Construction And Extrinsic Evidence," limited to the twelve selected "Mini-Markman"
4 patent claims. Microsoft's preliminary claim construction is based upon the proposed terms,
5 phrases and clauses, and claims as a whole, identified by the parties in their submissions in
6 accordance with Patent Local Rule 4-1(a) and conference in accordance with Patent Local Rule 4-
7 1(b).

8 Microsoft provides its preliminary claim construction of each of the 12 "Mini-Markman"
9 claims subject to the limitations and reservations of rights set forth herein. Microsoft does not
10 waive any defenses that the asserted claims fail to satisfy the provisions of 35 U.S.C. § 112
11 including, for example, the written description requirement, the definiteness requirement, or any
12 other requirement for patentability. Microsoft does not concede that the asserted claims are
13 supported by Plaintiff's original application or any application from which they purportedly claim
14 priority. Specifically, by offering a construction of a term, Microsoft does not waive any defense
15 that the claim is in fact indefinite and there can be no proper construction.

16 Microsoft provides its preliminary claim construction in the following format. Exhibit A
17 sets forth Microsoft's preliminary construction of (1) the claim term "virtual distribution
18 environment" ("VDE"), (2) the "VDE invention" disclosed in the February, 1995, InterTrust
19 patent application, and (3) certain other claim terms. Exhibit B sets forth Microsoft's preliminary
20 construction of the disputed claims as a whole, and particular claim phrases in dispute, in the
21 order of appearance in a claim. Where an individual claim term (within a phrase) is also in
22 dispute, it will be bold-faced in Exhibits A and B. Exhibit C sets forth Microsoft's preliminary
23 construction of the individual terms in dispute, in alphabetical order.

24 Microsoft reserves the right to modify its preliminary claim constructions in the event that
25 the parties are unable to agree upon a particular claim construction. Furthermore, because
26 InterTrust has not yet fully complied with the disclosure requirements of Patent Local Rules 3-1
27 and 3-2, Microsoft expressly reserves the right to amend its preliminary claim construction if
28

1 evidence becomes available through those disclosures (or that should have been provided therein)
2 that would support amended constructions. Microsoft further reserves the right to amend its
3 preliminary claim constructions once it has an opportunity to review InterTrust's preliminary
4 claim constructions and once the parties have further met and conferred as required.

5
6 Preliminary Identification of Evidence in Support of Claim Construction

7 Microsoft's preliminary claim construction is supported by the intrinsic record of the
8 seven U.S. patents from which the 12 "Mini-Markman" claims are selected. For the purposes of
9 submission of this preliminary claim construction only, Microsoft treats the "intrinsic" evidence
10 as including: 1) the specifications of each of the seven U.S. patents at issue in the "Mini-
11 Markman" proceeding, including any material purportedly incorporated by reference therein;
12 2) the prosecution history of each of the seven patents at issue, including the applications and
13 prosecution history of the seven patents and any related patent applications, including without
14 limitation, applications purportedly incorporated by reference or to which an application claimed
15 priority; and 3) all references cited in the prosecution of any such applications. In accordance
16 with the local rules, this evidence is not specifically identified, except to the extent that Microsoft
17 asserts particular sections of a patents' specifications provide "structure" for claims properly
18 construed under 35 U.S.C. § 112(6).

19 In certain circumstances, Microsoft's preliminary construction may be supported by
20 extrinsic evidence presently available to Microsoft. Microsoft reserves the right to modify or
21 supplement with evidence that it has not yet been able to fully review, due to InterTrust's
22 production, including without limitation, InterTrust re-production of over 1,000,000 pages on
23 November 4, 2002. Microsoft reserves the right to supplement with additional evidence gathered
24 in the course of the discovery collected between now and the close of "claim construction"
25 discovery or later submitted by InterTrust in full compliance with its disclosure obligations under
26 Patent Local Rules 3-1 and 3-2. Extrinsic evidence is identified or produced in accordance with
27 the local rule and set forth in the following exhibits:
28

1 Exhibit D: Contains copies of excerpts from dictionaries and other publications. Due to
2 the volume of the appended pages, Exhibit D will be served via Federal Express.

3 Exhibit E: Contains a list of selected production documents, identified by initial bates
4 number.

5 Exhibit F: Contains a list of selected, uncited prior art publications, identified by bates
6 number(s).

7 Exhibit G: Contains a list of selected, uncited prior art patents, identified by bates
8 number(s).

9 In addition to the extrinsic evidence cited in Exhibits D-G, Microsoft incorporates by
10 reference herein and reserves the right to rely upon: 1) all documents identified by InterTrust in
11 response to discovery or pursuant to the Patent Local Rules; 2) all InterTrust patents,
12 publications and other things that are prior art to any Mini-Markman claim; and 3) the testimony
13 of InterTrust and the witnesses identified below.

14
15 Preliminary Identification of Witnesses¹

16 **Professor John Mitchell:** Dr. Mitchell will testify of the following matters:

17 1) that certain of the presently disputed terms and phrases used in the twelve claims are
18 amorphous terms lacking a well-defined, precise meaning that can accurately be gleaned from
19 technical or other dictionaries. Rather, these terms are used in the art and/or in the patents in a
20 manner that requires close consideration of the entire patent specification to put them in proper
21 context and determine their precise, correct meaning as used in the patents. These terms include
22 "secure container," "control," "govern," "protect," "protected processing environment," "secure,"
23 "securely," "security," "virtual distribution environment";

24 2) that the concepts stated in the InterTrust patents were known to the art, including the
25 cited prior art, which cited art he will describe;

26
27 ¹ In accordance with the local rules, Microsoft identifies witness testimony that it contends will
28 support its construction. It has not identified herein testimony relevant to the "tutorial" to be held
prior to the claim construction hearing.

1 3) the level of skill, background, and understanding (including extent thereof) of the
2 relevant patent application disclosures by a person of skill in the art; and

3 4) the meaning and scope certain disputed claim language, including "secure container,"
4 "control," "govern," "protect," "protected processing environment," "secure," "securely,"
5 "security," and "virtual distribution environment."

6 **Professor David Maier:** Dr. Maier will testify on the following matters:

7 1) what the February 13, 1995, patent application (SN 08/388,107) and the seven
8 InterTrust patents, described as the "invention;" more particularly, what are the required,
9 necessary, non-optional features of the "VDE" "invention" as stated in the patents. This
10 description will include an explanation of the features set forth in Microsoft's "Global
11 Constructions" (Exhibit A).

12 2) what the February 13, 1995, patent application (SN 08/388,107) and the seven
13 InterTrust patents, required as necessary, non-optional building blocks to implement the "VDE"
14 "invention" as stated in the patents.

15
16 Dated: December 20, 2002

17
18 By: 

19 WILLIAM L. ANTHONY
20 ERIC L. WESENBERG
21 HEIDI L. KEEFE
22 ORRICK HERRINGTON & SUTCLIFFE, LLP
1000 Marsh Road
Menlo Park, CA 94025
Telephone: 650-614-7400

23 STEVEN ALEXANDER
24 KRISTIN L. CLEVELAND
25 JAMES E. GERINGER
26 JOHN D. VANDENBERG
KLARQUIST SPARKMAN, LLP
One World Trade Center, Suite 1600
121 S.W. Salmon Street
27 Portland, OR 97204
28 Telephone: 503-226-7391

MICROSOFT CORPORATION'S PATENT LOCAL
RULE 4-2 DISCLOSURE (LIMITED TO "MINI-
MARKMAN" CLAIMS), CASE NO. C 01-1640 SBA

Attorneys for Defendant
MICROSOFT CORPORATION

Of Counsel:

T. Andrew Culbert, Esq.
Microsoft Corporation
One Microsoft Way
Building 8
Redmond, WA 98052-6399
Telephone: 425-882-8080

